

Remarks

Reconsideration of the present application, as amended, is respectfully requested.

In the specification, a typographical error on the last paragraph on page 7 was corrected by adding the omitted word, "information," after "promotion." The correction avoids a meaningless tautology in the sentence in which the amendment is made, and is consistent with the applicant's description of consumer information gathering and the present invention. E.g., *see* page 4, lines 20-24, and page 6, lines 5-8, of the specification.

Of pending claims 1-17, 19-27 and 36-48, all were rejected. The rejections were based on objections for adding new matter into the claims not supported in the originally filed specification as prohibited under 35 U.S.C. §132(a); on objections to the specification for not clearly describing the claimed invention as required under 37 C.F.R. §1.71; as containing subject matter not described in the originally filed specification as required by 35 U.S.C. §112, first paragraph; and for indefiniteness prohibited by 35 U.S.C. §112, second paragraph. The applicant respectfully disagrees and addresses each issue accordingly.

I. The Applicant Has Not Added New Matter to the Claims

The previous amendment was objected to under 35 U.S.C. §132(a) because the amendment purportedly introduced new matter into the disclosure. The purported new matter was identified in the amended claims as:

"...determining, using the at least one computer network system, whether said identified consumer has made an acknowledgement of said promoting within the predetermined time period, said acknowledgement not including an attempt by said identified consumer to purchase said first selected item...."

The Examiner cited the specification at line 29+ of page 7: "An acknowledgement might be the act of browsing through the webpage or a positive response to accept the promotion offer might be required," and concluded, "The specification teaches that the acknowledgement might be at least one of the aforementioned actions, i.e. browsing or a positive response. However, the specification fails to teach that the acknowledgement by the consumer does not include an attempt (by the consumer) to purchase the selected product)" "prolonging, using the at least one

computer network system, the promoting beyond the predetermined time period upon determining that said consumer has made the acknowledgement of said promoting within the predetermined period." The Examiner further stated:

"[T]he specification is silent about the manner in which the prolonging of the promotion (delay the termination of the inverted promotion, page 7 L 33-34) is carried out in terms of the acknowledgement, in particular, the specification fail to teach that the prolonging is based on the acknowledgement as defined in the claim limitation. The specification teaches that the prolonging is done whenever there is acknowledgment of the promotion by the consumer)."

Claim 36: "determining when said computer network system is not in normal operation..". wherein responsive to said determining, said method further comprising: "recording by said computer network a price paid for said first selected item by said consumer at a location (Examiner's underlining)."

This feature is not disclosed in the specification. At paragraph line 14+ on page 10 the specification recites when the computer server handling the promotion is down, ...the consumer cannot receive the special discount or price of ..inverted promotion." The specification is silent about determining the condition or status of the computer network and recording by the computer network a price paid for in response to such determining.

The applicant respectfully disagrees. The Examiner has apparently read the applicant's specification disjointedly and skipped a significant portion of the specification. In the Background of the Invention which establishes a context for the present invention, the specification on page 2, lines 13-21, states:

Up to now, promotion efforts have required the consumer to take a specific action to enable his or her discounts on a product or service. For instance, the consumer is required to bring in a paper coupon or token for redemption. In a modern supermarket, the consumer must make one or more selections at a kiosk or web site, bring in a paper coupon or token, or make a specific purchase that triggers a coupon or token to be printed or otherwise issued to enable his discount at the checkout counter. In contrast, the present invention inverts the promotion via predetermination without explicit selection so as to invite more participation from the consumer. As a result, the consumer's response to the incentive contributes more consumer information. (Applicant's underlining.)

The examples of "a specific action" described above are purchases or attempts to purchase the promoted item, which are contrasted with the claimed inverted promotion of the present invention. That is, a consumer brings in a paper coupon or token for redemption for no other reason than to purchase the promoted item. It should be clear that the present invention excludes

attempts to purchase the promoted item and no new matter is being introduced into the specification.

With respect to claim 36, the applicant has amended the claim to eliminate the language, “responsive to said determining.” The claim should now overcome the Examiner’s objection.

II. The Applicant’s Specification Fully Describes the Claimed Invention

The specification was also objected to for purportedly failing to meet the requirements of 37 C.F.R. §1.71. The Examiner stated:

In regards to the specific requirements outlined above, the specification does not describe completely a specific embodiment of claims 1-17, 19-27 and 36-48 in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same. In particular, the specification fails to describe limitation of claimed invention “prolonging, using the at least one computer network system, the promoting beyond the predetermined time period upon determining that said consumer has made the acknowledgement of said promoting within the predetermined period.” per independent claims 1. There is no reference in the specification as originally filed regarding (i) determining that the acknowledgement is caused by an event that does not include an attempt by the identified consumer to purchase the item and (ii) that the prolonging (holding cancellation of the promotion in abeyance or delay the termination of the inverted promotion, p.7 L 29-34) is solely based upon the acknowledgement that does not include an attempt to purchase the selected product. The specification teaches that the promotion is prolonged regardless of how the selected consumer has acknowledged the promotion, i.e. whether browsing through the webpage or a positive response to accept the promotion offer (i.e. an attempt to purchase the product). In other words, the specification does not distinguish, the act of prolonging of promotion solely based upon the acknowledgement that does not include an attempt by the consumer to purchase the selected item (i.e. via mere act of browsing through the webpage).

The applicant respectfully disagrees. Having contrasted the invention with the prior art and what the invention is not, i.e., *see* the above quoted portion of the specification at page 2, lines 13-21, the rest of specification describes what the invention is. For example, the invention was summarized on page 2, lines 25-33:

The method includes identifying a consumer by a unique identifier; promoting a selected item with a discount or special price to the identified consumer; withdrawing the discount to the identified consumer; granting the discount or special price upon purchase of the item by the identified consumer

prior to the withdrawing step; and holding the withdrawing step in abeyance upon an acknowledgment of the promoting step by the identified consumer. Stated differently, the identified consumer must take specific action to prevent a promotional discount from being withdrawn. By doing so, the present invention provides for greater incentives for the consumer to provide information about his or her purchasing habits.

Note that with the repudiation of purchases and attempts to purchase, the “specific action” is distinguished from an attempt to purchase the selected item. Otherwise, a foiled purchase resulting in an attempt to purchase, as described in the Examiner’s cited Caldor reference, hardly provides the “greater incentives for the consumer to provide information about his or her purchasing habits.” Were attempts to purchase included as part of the applicant’s claimed invention, as the Examiner insists, the applicant’s invention then oddly includes eliciting more information from a consumer by frustrating his or her purchase so that a certain purchase becomes a possible purchase. A frustrated and angry consumer, albeit mollified by the Caldor “rain check”, is not what the applicant or anyone in the field is seeking and it should be evident that this is not a good method of obtaining more information from a consumer.

The Examiner concludes:

The specification teaches that the promotion is prolonged regardless of how the selected consumer has acknowledged the promotion, i.e. whether browsing through the webpage or a positive response to accept the promotion offer (i.e. an attempt to purchase the product). In other words, the specification does not distinguish, the act of prolonging of promotion solely based upon the acknowledgement that does not include an attempt by the consumer to purchase the selected item (i.e. via mere act of browsing through the webpage).

This is a misreading of the applicant’s specification taken from page 7, lines 29-33, of the specification and illustrates the perils of not placing selections of a specification in context. As pointed out above, the present invention does not include attempts to purchase, as described explicitly at page 2, lines 13-21. Furthermore, the particular promotion described is in the context of an Internet promotion (*see* page 7, line 22). The applicant description of an acknowledgement as “a positive response to accept the promotion offer” cannot be an attempt to purchase the product, as the Examiner argues. In electronic commerce, an attempt to purchase a product should result in the immediate purchase of the product due to the instantaneous nature of communication

between the buyer and seller, between the seller and his stocking warehouse, between the buyer's financial institution and the seller's financial institution, e.g., bank, etc. For attempts to purchase to be included as an acknowledgement, one skilled in the art would certainly expect a description or an allusion to some "glitch," "outage," or other form of electronic misbehavior. Hence in the context of the specification description, it should be evident that an acknowledgement did not include attempts to purchase.

A more complete quotation of page 7, line 29 - page 8, line 3 of the specification yields:

An acknowledgment by the selected consumer might be the act of browsing through the webpage or a positive response to accept the promotion offer might be required. In accordance with the present invention, any scheduled cancellation of the promotion is held in abeyance to allow the consumer to receive the benefits of the promotion in exchange for receiving the promotion information. The consumer may be offered an opportunity to delay the termination of the inverted promotion. For example, an inverted promotion due to expire on one day may have its termination delayed so that the consumer can shop at a more convenient time and still receive the benefits of the inverted promotion.

Note the description of the result of the delay in the termination of the promotion is that the consumer can shop at a more convenient time with the benefits of the promotion. That is not the result of an attempt to purchase.

Hence the applicant's specification does distinguish between attempts to purchase and the claimed consumer acknowledgements. The specification fully describes the claimed invention.

III. The Subject Matter of the Claims Is Described in the Originally Filed Specification

Claims 1-17, 19-27 and 36-45 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the claims were rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth in the objection to the specification.

The applicant respectfully disagrees. As pointed out above, the specification fully supports the present language of the claims and one skilled in the art would fully understand the applicant's claimed invention. Claims 1-17, 19-27 and 36-45 should not be rejected.

IV. Amended Claim 36 is Not Indefinite.

Claim 36 was rejected under 35 U.S.C. §112, second paragraph, for indefiniteness. Specifically, the Examiner stated:

Claim 36 recites "determining when said computer network system is not in normal operation..". wherein responsive to said determining, said method further comprising:

"recording by said computer network a price paid for said first selected item by said consumer at a location."

It is unclear, how the computer network when not in (normal) operation can record a price paid by a consumer. (Examiner's underlining.)

As pointed out earlier, the applicant has amended claim 36 to remove the language underlined by the Examiner. The language of claim 36 now reads, "...when said computer network system is not in normal operation that said granting could not be performed, recording...." Note that the claim is consistent with the specification on page 10, lines 14-25.

Therefore, in view of the amendments above and the remarks directed thereto, the applicant respectfully requests that all rejections be removed, that claims 1-17, 19-27 and 36-48 be allowed and that the case be passed to issue. If a telephone conference would in any way expedite the prosecution of the application, the Examiner is requested to call the undersigned at (408) 868-4088.

Respectfully submitted,

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